UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,042	06/26/2001	Dale F. McIntyre	82994F-P	1724

7590   10/19/2005

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EXAMINER
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ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/892,042	MCINTYRE, DALE F.
	Examiner	Art Unit
	Kenneth R. Coulter	2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>13 September 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   The claimed invention (claims 12 – 17) is directed to non-statutory subject matter.

Independent claims 12 and 17 are directed to software that is not implemented on a **computer readable storage medium**.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Niamir

(U.S. Pub. No. 2002/0027567) (Listing Network for Classified Information).

4.1   Regarding claim 1, Niamir discloses a method for managing digital image media

files comprising the steps of:

        providing a server for managing access to a digital image media collection stored

on a remote user computer of a user, said digital image media collection having at least

one digital media file, said at least one digital media file having at least one image file of

a predetermined resolution, said server capable of communicating over a

communication network with said user computer, said user providing an initial

authorization for managing of said digital images by said server (Abstract; Figs. 1, 2;

paragraph 99); and

        controlling automatic periodic access by said server to said image media

collection in said user computer without any further authorization by said user (Abstract;

Figs. 1, 2; paragraphs 53, 74).

4.2   Per claim 2, Niamir teaches a method according to claim 1 further comprising the steps of: creating a copy of said at least one digital image file, said copy having a resolution lower than said predetermined resolution (paragraph 165 "thumbnail images may be cached to other DLLSs 18A")

4.3   Regarding claim 3, Niamir discloses a method according to claim 2 wherein each of said at least one digital image media file includes additional data with respect to said at least one digital image file (paragraph 57).

4.4   Per claim 4, Niamir teaches a method according to claim 3 wherein said additional data comprises audio data (paragraph 57 "audio or video files").

4.5   Regarding claim 5, Niamir discloses a method according to claim 3 wherein said additional data comprises data structure information relating to said at least one digital image media file (paragraph 57 "detailed descriptions").

4.6   Per claim 6, Niamir teaches a method according to claim 2 further comprising the step of: forwarding said copy to a third party (paragraphs 53, 74).

4.7   Regarding claim 7, Niamir discloses a method according to claim 2 further

comprising the step of: forwarding said copy to a fulfillment provider for providing of

goods and/or services with respect to said copy (Abstract; Figs. 1, 2).

4.8   Per claim 8, Niamir teaches a method according to claim 7 wherein said

fulfillment provider automatically accesses said at least one digital image of a

predetermined resolution from said user computer over said communication network

(Abstract; Figs. 1, 2; paragraph 165).

4.9   Regarding claim 9, Niamir discloses a method according to claim 1 wherein

instructions regarding providing of goods and/or services are provided automatically

(paragraphs 33, 102 "goods or services").

4.10   Per claim 10, Niamir teaches a method according to claim 9 wherein said

instructions are obtained by analyzing said digital image files with respect to a

predefined icon representative of instructions (paragraphs 33, 102).

4.11   Regarding claim 11, Niamir discloses a method according to claim 10 wherein

said icon is at least a portion of an image of an individual (paragraph 165 "thumbnail

images").

4.12   Per claims 12 – 19, the rejection of claims 1 – 11 under 35 USC 102(e)

(paragraphs 4.1 – 4.11 above) applies fully.

Response to Arguments

5.   Applicant's arguments filed 7/8/05 have been fully considered but they are not

persuasive.

Applicant argues that "the server automatically and periodically accesses the collection

without any further authorization by the user."

No claim in the present Application teaches the combination of these features.

Applicant argues that Niamir does not teach the limitations of claim 2.

Examiner disagrees.

The Examiner has equated the thumbnail images of Niamir to the limitations of claim 2

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenneth R. Coulter whose telephone number is 571

272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER

krc